UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,594	05/29/2001	David W. Boreham	P5836	6565

7590	10/27/2003

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EXAMINER
LU, KUEN S

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application		Applicant(s)
	09/867,594		BOREHAM ET AL.
	Examiner		Art Unit
	Kuen S Lu		2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Drawings

1.   The drawings filed on 5/29/2001 are <u>not approved</u> by the Draftsperson under 37

CFR 1.84 or 1.152, formal drawings are required in response to this office action,

Figures 1-24.

   The drawings are objected to as failing to comply with 37 CFR 1.84(p) because

Figure legends are poor. A proposed drawing correction or corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The

objection to the drawings will not be held in abeyance.

Claim Objections

2.   Claims 14-16 are objected to because of the following informalities: The claims are

dependent on an apparatus claim 13, however, each of the claims 14-16 starts with the

phrase "The method as in claim 13,". The terms "method" in the claims 14-16 are

inconsistent with the term "apparatus" in claim 13. Appropriate correction is required.

Double Patenting

   A rejection based on double patenting of the "same invention" type finds its support in the
language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process
... may obtain <u>a</u> patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context,
means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894);
In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619
(CCPA 1970).

   A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or
amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal
disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

3.   Claims 5 and 6 are provisionally rejected under 35 U.S.C. 101 as claiming the

same invention as that of claims 6 and 7, respectively, of copending Application No.

09/867595. This is a <u>provisional</u> double patenting rejection since the conflicting claims

have not in fact been patented.

> The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
> A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
> Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 1,7,9,13 and 14 are provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claim

1,8,10,15 and 17, respectively, of copending application No. 09/867595. Although the

conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of instant invention substantially recites the limitation of claim 1 of

09/867595. The distinction between the two claims is that the definition entry of the

instant invention includes specifier attribute for target entry while the 09/867595

application includes one or more template entries. It would have been obvious to one of

ordinary skill in the art of directory data repository to create the definition entry

comprising of target and template entries through the association of attributes or DN

value of the entries because it would allow the sharing of attributes and the ordinary

artisan would create a CoS scheme comprising of both definition and template entries.

Claim 7 of instant invention and claim 8 of 09/867595 application are both directed

to a method for determining if a CoS specifier associated with a matched attribute-value

pair matches a CoS entry. The 09/867595 application determines the match of CoS specifier against the destined entry obtained through the association of attribute-value pair, while the instant invention matches CoS specifier against the valid second target entry. It would have been obvious to one of ordinary skill in the art of directory data repository to determine the match through searching directly to the second target entry or by association of attribute-pair because it would search through the definition, target and template entry schemes and it would allow the ordinary artisan to retrieve the

Claim 9 of instant invention and claim 10 of 09/867595 application are both directed to an apparatus component for creating CoS scheme comprising of a definition entry where the 09/867595 application further includes a specifier and a list of attributes in the definition entry while the instant invention does not have such a limitation, however, further extends directory CoS with one or more template entries. It would have been obvious to one of ordinary skill in the art of directory server to create CoS scheme to broadly include specifier and other attributes in the definition entry and further extend the association of attributes to other entries, such as target or template, because it would allow the ordinary artisan to create a complete definition of CoS scheme and thoroughly retrieve the directory.

Claim 13 of instant invention and claim 15 of 09/867595 are both directed to an apparatus component to configure an attribute-value pair that could be shared by target entries. The instant invention limits the entries to using an indirect CoS scheme while the application 09/867595 does not have such a limitation. It would have been obvious to one of ordinary skill in the art of directory server to configure the attribute-value pair

of directory server entry without such limitation, because it would allow the ordinary

artisan to have flexibility for creating the pair for any type of entry schemes, for example,

indirect, classic, pointer or template.

Claim 14 of the instant invention and claim 17 of 09/867595 are both directed to

configure an apparatus component for applying a set of constraints on a list of matched

attribute-value pairs. The 09/867595 application determines the match of CoS specifier

against the destined entry obtained through the specifier attribute of definition entry,

while the instant invention matches CoS specifier against the valid second target entry.

It would have been obvious to one of ordinary skill in the art of directory data repository

to determine the match through both methods because it would search through the

definition, target and template entries of various schemes and it would allow the

ordinary artisan to retrieve the directory data more complete and efficiently.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form
the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5.   Claims 1-16 are rejected under 35 U.S.C. 102(a) as anticipated by iPlanet Directory

Server Administrator's Guide (Version 5.0, April 2001, Sun Microsystems, Inc., hereafter

iPlanet).

As per claims 1 and 9, iPlanet teaches the following:

"a method configuring a directory server comprising a plurality of entries" at Page 19,

Para. "Introduction", lines 1-2 by implementing iPlanet as a LDAP protocol based

directory server, and at Page 37, Para. "Managing Entries..." by creating a root entry

and directory entries;

"creating a CoS scheme," at Page 171, Section "Creating a new CoS" steps 1 through

8, and "wherein the CoS scheme comprises a CoS Definition entry" at Page 170

diagram by showing the CoS definition entry of (cn=IndirectCos, dc=siroe, dc=com),

"which includes a CoS specifier and a list of attributes" by showing attributes

cosIndirectSpecifier and cosAttribute, and "where a first target entry within scope of CoS

scheme obtains values for attributes provided in the CoS definition entry by using an

attribute with a distinguishing name (DN) value contained within the first target entry" by

showing the values 'manager' and 'departmentNumber' for attributes osIndirectSpecifier

and cosAttribute in the definition entry obtained from distinguishing name manager in

the Target Entry of (cn=wholiday...).

As per claims 2 and 10, iPlanet teaches "DN points to a second target entry which is

a valid entry" at Page 170 diagram by showing manager attribute in the target entry

pointing to the DN entry (cn=Carla Fuentes...) in the Template Entry.

As per claims 3 and 11, iPlanet teaches "DN points to a second target entry which is

a valid entry and the first entry uses the second target entry as a template" at Page 170

diagram as applied to Claim 2, and the entry (cn=wholiday...) uses entry (cn=Carla...)

as a template.

As per claims 4 and 12, iPlanet teaches "the value of the CoS specifier in the CoS Definition entry appears in a target entry as a first attribute type" at Page 170 diagram by showing the value of attribute cosIndirectSpecifier, which is manager, as the first attribute type in the target entry.

As per claims 5 and 13, iPlanet teaches "attribute-value pair stored in a directory system and shared by a plurality of target entries in the directory system" at Page 170 diagram by showing the sharing of attribute-value pairs cosIndirectSpecifier-manager and cosAttribute-departmentNumber between target and definition entries;

"creating an indirect CoS scheme" at Pages 171-173, steps 1 through 8;

"receiving a request for an attribute-value pair associated with a first target entry" at Page 172, step 6;

"searching in a list of attribute-value pairs which are associated with template entries that are in turn associated with CoS Definition entries for instances of attribute value pairs that match the requested attribute type, said searching step resulting in a matches list of attribute-value pairs" at Pages 172-173, step 7;

"applying at least one of a set of constraints to the matched list of attribute-value pairs" at Page 172, step 7 by using the value of one of the target entry's attribute; and

"returning the attribute-value pair that satisfied the applied constraint(s)" at Page 173 by using both its DN and the value of the target entry's attributes and step 8.

As per claims 6 and 14, iPlanet teaches "set of constraints includes CoS scope" at Page 173, lines 2-3 by showing one of the target entry's attributes, a classic CoS.

As per claims 7 and 15, iPlanet teaches "the set of constraints includes determining if a CoS specifier associated with the matched attribute-value pair matches a valid second target entry" at Page 169, section "How an Indirect CoS Works" by using manager attribute of the target entry to identify the template entry.

As per claims 8 and 16, iPlanet teaches "the matched second target entry contains an attribute provided in the indirect CoS scheme" at Page 170 by showing pointers of attribute departmentNumber in both template and target entries.

Conclusions

6.   The prior art made of record

A. iPlanet Directory Server Administrator's Guide, Version 5.0,

Sun Microsystems, Inc. Doc. ID 816-0799-01, April, 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KL

Patent Examiner

October 20, 2003
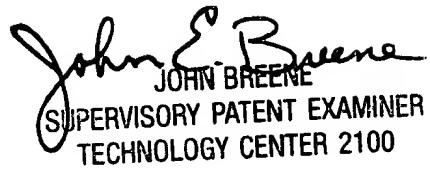
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